ECORD
AND
BRIEFS

No. 15-866

Supreme Court, U.S.
FILED
SEP 21 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

STAR ATHLETICA, L.L.C.,

Petitioner,

v.

VARSITY BRANDS, INC., ET AL.,

Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

BRIEF OF PROFESSORS JEANNIE SUK GERSEN AND C. SCOTT HEMPHILL AS *AMICI CURIAE* IN SUPPORT OF RESPONDENTS

JEANNIE SUK GERSEN
HARVARD LAW SCHOOL
1563 Massachusetts Ave.
Cambridge, MA 02138

C. SCOTT HEMPHILL
NEW YORK UNIVERSITY
SCHOOL OF LAW
40 Washington Sq. South
New York, NY 10012

SCOTT B. WILKENS
Counsel of Record
MATTHEW S. HELLMAN
SAMUEL C. BIRNBAUM*
JENNER & BLOCK LLP
1099 New York Ave. NW
Suite 900
Washington, DC 20001
(202) 639-6000
swilkens@jenner.com

**Admitted only in New York. Practicing under the supervision of the partnership of Jenner & Block LLP.*

Counsel for Amici Curiae

September 21, 2016

QUESTION PRESENTED

What is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act?

TABLE OF CONTENTS

QUESTION PRESENTED i

TABLE OF AUTHORITIES iii

INTEREST OF AMICI CURIAE 1

SUMMARY OF ARGUMENT 1

ARGUMENT 4

I. General Copyright Principles Apply To Useful Articles. 4

II. The Term "Utilitarian Function" In Section 101 Refers To Mechanical Or Similarly Practical Utility, Not Every Possible Benefit. 12

III. Expressive Features Are Conceptually Separable Where They Are Not Dictated By Utilitarian Function. 19

IV. The Copyrightability Of Overall Design Of Clothing Is Not At Issue In This Case 28

CONCLUSION 30

TABLE OF AUTHORITIES

Page(s)

CASES

Baby Buddies, Inc. v. Toys "R" Us, Inc.,
611 F.3d 1308 (11th Cir. 2010) 20

Baker v. Selden,
101 U.S. 99 (1879) 6, 7, 10, 16, 17, 18

Bleistein v. Donaldson Lithographing Co.,
188 U.S. 239 (1903) 23

Carol Barnhart Inc. v. Economy Cover Corp.,
773 F.2d 411 (2d Cir. 1985) 21, 22

Chosun International, Inc. v. Chrisha Creations, Ltd.,
413 F.3d 324 (2d Cir. 2005) 20-21

Corley v. United States,
556 U.S. 303 (2009) 15

Fashion Originators' Guild of America, Inc. v. FTC,
312 U.S. 457 (1941) 29

Feist Publications, Inc. v. Rural Telephone Service Co.,
449 U.S. 340 (1991) 28

Gay Toys, Inc. v. Buddy L Corp.,
522 F. Supp. 622 (E.D. Mich. 1981),
vacated, 703 F.2d 970 (6th Cir. 1983) 14, 15

Gay Toys, Inc. v. Buddy L Corp.,
703 F.2d 970 (6th Cir. 1983) 15

Kieselstein-Cord v. Accessories by Pearl, Inc.,
632 F.2d 989 (2d Cir. 1980) 21, 22

Kirtsaeng v. John Wiley & Sons, Inc.,
133 S. Ct. 1351 (2013) 19, 20, 29

Mazer v. Stein,
347 U.S. 201 (1954) 7, 8, 9, 17, 25

Peel & Co., Inc. v. The Rug Market,
238 F.3d 391 (5th Cir. 2001) 17, 23

Pivot Point International, Inc. v. Charlene Products, Inc.,
372 F.3d 913 (7th Cir. 2004) 20, 21

Tilley v. TJX Companies,
345 F.3d 34 (1st Cir. 2003) 23

Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.,
338 F.3d 127 (2d Cir. 2003) 17, 23

Universal Furniture International, Inc. v. Collezione Europa USA, Inc.,
618 F.3d 417 (4th Cir. 2010) (per curiam) 20

STATUTES AND RULES

17 U.S.C. § 101 ..... 4, 5, 6, 12, 14, 15, 20, 26

17 U.S.C. § 102(a) 28

37 C.F.R. § 202.8 (1949) 8, 9

37 C.F.R. § 202.10(c) (1959) 8

OTHER AUTHORITIES

Compendium of U.S. Copyright Office Practices § 924.2(B) (3d ed. 2014) 29, 30

1 P. Goldstein, Copyright § 2.5.3 (3d ed. 2016 Supplement) 7, 8

H.R. Rep. 94-1476 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659 ..... 8, 12, 14, 17, 20

C. Scott Hemphill & Jeannie Suk, *The Fashion Originators' Guild of America: Self-Help at the Edge of IP and Antitrust*, in *Intellectual Property at the Edge: The Contested Contours of IP* 159 (Rochelle C. Dreyfus & Jane C. Ginsburg eds., 2013) 29

C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147 (2009) 28

1 M. Nimmer & D. Nimmer, Copyright (2016) 9, 10, 22

Oxford English Dictionary (1933) 13

2 W. Patry, Copyright (2016) 7, 8, 15, 21, 22

Webster's Third New International Dictionary (1966) 13

INTEREST OF AMICI CURIAE[1]

Amici are law professors at universities in the United States and teach, research, and write extensively on intellectual property law, including copyright law. They have no personal interest in the outcome of this case. Instead, they have a professional interest in ensuring that the copyright law is interpreted in a consistent, well-reasoned manner, with close adherence to the statutory text and this Court's foundational copyright jurisprudence. *Amici* are:

Jeannie Suk Gersen
John H. Watson, Jr. Professor of Law
Harvard Law School

C. Scott Hemphill
Professor of Law
New York University School of Law

Institutional affiliations are given for identification purposes only.

SUMMARY OF ARGUMENT

The question presented by this case goes to the heart of copyright law and implicates the Copyright Act's guiding definitions as well as this Court's foundational precedents reaching back to the 1870s.

In the Copyright Act, Congress carefully addressed the copyrightability of works of authorship that possess utilitarian functions. In defining "useful article" in

---

[1] Pursuant to Rule 37.6, *amici* affirm that no counsel for a party authored this brief in whole or in part and that no person other than *amici* and their counsel made a monetary contribution to its preparation or submission. Petitioner's and Respondents' consent to the filing of *amicus* briefs is filed with the Clerk.

section 101 of the Copyright Act, Congress made clear that the design of a useful article, whether two-dimensional or three-dimensional, is protectable as a pictorial, graphic, or sculptural work, as long as its pictorial, graphic, or sculptural features are separable from its utilitarian aspects. This definition codified this Court's decisions in *Baker v. Selden* and *Mazer v. Stein*, which, among other things, rejected any notion that useful articles are categorically excluded from copyright. Section 101 thus closely implements the understanding that existed prior to the 1976 Copyright Act. "Useful articles" do not stand apart from the rest of copyright as a carved out exception to protectability, but rather, like all other works, are subject to copyright's general conditions of protectability.

In contrast, Petitioner and its *amici* seek to carve out garment designs as a special category of works that are unprotectable. In doing so, Petitioner and its *amici* would undermine the coherence of copyright law and would render unprotectable not only garment designs but a far broader swath of works, including many that have long been protected. That result is entirely unwarranted.

Petitioner and its *amici* assert that the term "utilitarian function" in section 101's definition of "useful article" means something extremely broad. That interpretation cannot be correct, because it has the practical effect of excluding useful articles from copyright, a result that *Baker v. Selden* and *Mazer v. Stein* squarely foreclose. Properly understood, "utilitarian" in section 101 refers to mechanical or similarly practical utility or usefulness. It does not refer to usefulness for aesthetic, decorative, or cultural purposes, such as making someone look attractive or

stylish. Those kinds of functions of a work are paradigmatic non-utilitarian functions, even though it is possible to characterize those functions of a work in some very broad sense as "useful." Treating a work's decorative function as "utilitarian" would make almost every pictorial, graphic, or sculptural work utilitarian and thus unprotectable, because almost every such work has that kind of decorative function. That understanding of "utilitarian" would not only lead to absurd results, but would also contradict the text and structure of section 101 and make a hash of the statute.

The dispositive question in this case is whether the pictorial, graphic, or sculptural features of a particular piece of clothing are separable from its utilitarian aspects. For the vast majority of clothing, such features are not separable because, in general, most clothing designs are dictated by utilitarian considerations. However, to the extent that the design may have pictorial, graphic, or sculptural features that are separable from utilitarian aspects, then those features are protectable. The instant *amici* propose the following test for separability, which is consistent with the statutory text and this Court's precedents: The design of a useful article is protectable if it is not dictated by, or necessary to, utilitarian or functional considerations. The Second Circuit has employed this analytical approach in several important cases, and it is the only test consistent with copyright law's longstanding principle that mere functional influences do not disqualify a work from copyright protection.

ARGUMENT

I. General Copyright Principles Apply To Useful Articles.

The area of copyright law dealing with "useful articles" suffers from two common and related misperceptions that run against the text of the Copyright Act: that useful articles are categorically excluded from copyright, and that the separability analysis is categorically more hostile to three-dimensional useful articles than to two-dimensional useful articles. These categorical ways of reasoning overcomplicate the Copyright Act, and have caused many lower courts to proliferate confusing, varied, and inconsistent tests that fail to follow the statute's simple logic.

In the Copyright Act, Congress carefully addressed the copyrightability of works of authorship that possess utilitarian functions. The Court should clarify that the statute's separability requirement for the protectability of "useful articles," whether those articles are two-dimensional or three-dimensional, is a logical manifestation of copyright's longstanding general approach to protectable works of authorship that possess utilitarian functions.

Whether a two-dimensional or three-dimensional "useful article" is protected by copyright is governed by section 101 of the Copyright Act, which provides in relevant part:

> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps,

> globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.
>
> . . .
>
> A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article."

17 U.S.C. § 101.

On its face, this language makes clear that "the design of a useful article," whether "two-dimensional" or "three-dimensional," is protectable as a "pictorial, graphic, or sculptural work," and explains the circumstances in which it is protectable: "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing

independently of, the utilitarian aspects of the article." 17 U.S.C. § 101.

The Supreme Court's landmark decision in *Baker v. Selden*, 101 U.S. 99 (1879), made clear well over a century ago that copyright may protect a work of authorship that has a utilitarian function, while not protecting the utilitarian function of that work. Thus, there simply has never been a blanket exclusion from copyright for works that have a utilitarian function. In *Baker v. Selden*, there was no question that a book that had the function of explaining a utilitarian system of bookkeeping was protectable, while the actual utilitarian system of bookkeeping explained in the book was not protectable. 101 U.S. at 104 ("The use of the art is a totally different thing from a publication of the book explaining it. The copyright of a book on book-keeping cannot secure the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book."). As the Court explained:

> But there is a clear distinction between the book, as such, and the art which it is intended to illustrate. The mere statement of the proposition is so evident, that it requires hardly any argument to support it. The same distinction may be predicated of every other art as well as that of book-keeping. A treatise on the composition and use of medicines, be they old or new; on the construction and use of ploughs, or watches, or churns; or on the mixture and application of colors for painting or dyeing; or on the mode of drawing lines to produce the effect of

> perspective, —would be the subject of copyright; but no one would contend that the copyright of the treatise would give the exclusive right to the art or manufacture described therein.

Id. at 102.

Following *Baker v. Selden*, works that possess utilitarian functions have long been understood to be copyrightable, so long as they satisfy the requirements specified by copyright law. The question then, has been how to determine to what extent works that possess utilitarian functions are copyrightable.

The 1976 Copyright Act, which set out the requirement that to be protectable, a useful article's design must have pictorial, graphic, or sculptural features that are separable from its utilitarian aspects, is widely thought to have given effect to the Copyright Office's interpretation of pre-1976 law, including its interpretation of this Court's decision in *Mazer v. Stein*, 347 U.S. 201 (1954), which is discussed below. 1 P Goldstein, Copyright § 2.5.3, p. 2:70 (3d ed. 2016 Supplement) (hereinafter "Goldstein"); 2 W. Patry, Copyright § 3:134, p. 3-415 (2016) (hereinafter "Patry") (stating that the "useful article" language in section 101 "is an amalgam of the 1948 and 1959 [Copyright Office regulations]").

The 1976 Copyright Act's legislative history makes this explicit. The House Report indicates that the first clause of section 101's definition of "'pictorial, graphic, and sculptural works,'" which includes "'works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned,'" tracks the Copyright Office's 1949 regulation relied

upon in *Mazer*. H.R. Rep. No. 94-1476, at 54 (1976) ("House Report"), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5667; 1 Goldstein § 2.5.3, p. 2:70.[2] The second clause, requiring that the protected subject matter be separable from the useful article's utilitarian aspects, tracks the Copyright Office's 1959 regulation interpreting *Mazer*. House Report, at 54-55; 1 Goldstein § 2.5.3, p. 2:70.[3]

In *Mazer v. Stein*, the Court examined whether a valid copyright existed in "statuettes of male and female dancing figures . . . . used as bases for table lamps, with electric wiring, sockets and lamp shades attached." 347 U.S. at 202. In answering this question in the affirmative, the Court rejected any notion that useful articles—in *Mazer v. Stein*, electric lamp bases—are categorically excluded from copyright. *Id.* at 214 ("The conclusion that the statues here in issue may be copyrighted goes far to solve the question whether their intended reproduction as lamp stands bars or invalidates their registration."); *id.* at 218 ("We find nothing in the copyright statute to support the argument that the intended use or use in industry of an

---

[2] That regulation, published at 37 C.F.R. § 202.8 (1949), provided that "[w]orks of art includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. " *Mazer*, 347 U.S. at 212-13.

[3] That regulation, codified at 37 C.F.R. § 202.10(c) (1959), provided that "[i]f the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art," those features are protected by copyright. 2 Patry § 3:133, p. 3-402.

article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law.").

In reaching its holding, the Court analyzed the development of copyright coverage from the founding of the Republic through the early 1950s, and concluded that "[t]he successive acts, the legislative history of the 1909 Act and the practice of the Copyright Office unite to show that 'works of art' and 'reproductions of works of art' are terms that were intended by Congress to include the authority to copyright these statuettes."[4] *Mazer*, 347 U.S. at 213-14. The Court relied heavily on *Baker v. Selden*, "reaffirming the gist of the holding in *Baker* and . . . the idea—first articulated in *Baker*—that useful works do not *ipso facto* become ineligible for copyright protection." 1 M. Nimmer & D. Nimmer, Copyright § 2A.05[B][1], p. 2A-26 (2016) (hereinafter "Nimmer") (conceding that prior editions of the Nimmer treatise had erroneously "interpreted *Mazer* to narrow the scope of the Court's holding in *Baker*").

In short, the 1976 Copyright Act relied heavily on pre-1976 Copyright Office regulations, which in turn relied heavily on *Mazer v. Stein* and *Baker v. Selden*. Section 101's specification of the circumstances under which "the design of a useful article" is protectable should thus be understood as a careful codification of *Baker v. Selden*'s conclusion: that the protection of a particular copyrightable work of authorship does not

---

[4] Indeed, the Court stated that "[a]s a standard we can hardly do better than the words of the present [1949] Regulation, naming the things that appertain to the arts." 347 U.S. at 214 (citation omitted). For the text of that regulation, published at 37 C.F.R. § 202.8 (1949), *see supra* note 2.

also extend to the utilitarian function of that very work. *Baker*, 101 U.S. at 102, 104; 1 Nimmer, § 2A.06, p. 2A-27 - 2A-28 ("much of the Court's holding in *Baker v. Selden* has since been codified in the current Act"). Some assume that section 101 somehow struck a death blow to the protectability of useful articles, *see* Petitioner's Brief ("Pet. Br.") at 24, but that is incorrect. Section 101 instead indicates the features of a useful article's design that are protectable, and in so doing, closely implements the understanding that existed prior to the 1976 Act, of copyright in works of authorship that possess a utilitarian function.

In light of the foregoing, it is also incorrect to think that the term "utilitarian function" in section 101's definition of "useful article" means something extremely broad and different from the very utilitarian function that *Baker v. Selden* and *Mazer v. Stein* meant to exclude from protectability in an otherwise copyrightable work of authorship. *E.g.*, Pet. Br. at 22, 38-39, 44-45 (defining utilitarian to include all of an article's "inherent, essential, or natural functions"; "[e]ven the slightest utilitarian function results in no copyright for the feature"); Brief of Professors Christopher Buccafusco and Jeanne Fromer as *Amici Curiae* in Support of Petitioner (hereinafter "Profs. Buccafusco & Fromer *Amicus* Br.") at 11 (defining utilitarian to include any "designs or aspects of designs . . . whose value is *dependent on their effect on other objects*"; concluding under this very broad definition that "[t]o the extent that aspects of garment design affect the way in which the wearer is perceived, they are utilitarian" (emphasis in original)). Interpreting "utilitarian" in such an expansive fashion has the practical effect of excluding "useful articles" from

copyright, a result that *Baker v. Selden* and *Mazer v. Stein* squarely foreclose. To the contrary, copyright protects a design of a useful article to the extent that its pictorial, graphic, and sculptural features can be separated from its utilitarian aspects.

In using the term "utilitarian aspects of the article," section 101 means the same thing in the context of "useful articles" that it means in any other copyright context involving works of authorship that also have a utilitarian function. In other words, "useful articles" do not stand apart from the rest of copyright as a carved out exception to protectability, but rather, like all other works, are subject to copyright's general conditions of protectability. Thus, if *Baker v. Selden* is understood to mean that utilitarian aspects of a work of authorship are not protectable, then similarly, in the subset of works of authorship that are considered "useful articles," utilitarian aspects of such useful articles are not protectable, but their pictorial, graphic, and sculptural features are.

As this case makes plain, the question of the separability of a useful article's utilitarian aspects from its pictorial, graphic, and sculptural features has led courts, litigants, *amici*, and commentators to adopt a dizzying array of standards and tests for separability. Brief of the Intellectual Property Law Association of Chicago as *Amicus Curiae* in Support of Neither Party at 8-11 (describing eleven different separability tests); Brief of *Amicus Curiae* New York Intellectual Property Law Association in Support of Neither Party at 13-17 (describing ten different separability tests). Petitioner's own proposed test includes four distinct steps and would cause a host of problems, discussed in Part III *infra*. Pet. Br. at 38-39. These many different

approaches to separability overcomplicate a simple statutory scheme. As this brief will explain, the proper test for "separability" for two-dimensional and three-dimensional works flows from and must respect copyright law's foundational principle that functional influences do not disqualify a work from copyright protection. The proper test for separability, set forth in Part III *infra*, therefore relies on the concept of conceptual separability, which is endorsed in the legislative history to the 1976 Copyright Act. *See* House Report, at 55.

II. The Term "Utilitarian Function" In Section 101 Refers To Mechanical Or Similarly Practical Utility, Not Every Possible Benefit.

"Utilitarian" in section 101 refers to mechanical or similarly practical utility or usefulness. It does not refer to usefulness for aesthetic, decorative, or cultural purposes. The statutory text expressly distinguishes the "*form*" or other aesthetic aspects of a "work[] of artistic craftsmanship" from the work's "*mechanical or utilitarian aspects*." 17 U.S.C. § 101 (emphasis added).

Thus, for example, "utilitarian" does not mean usefulness for making something or someone look attractive or beautiful, or showing that they are stylish. A painting may be useful for making a room look beautiful, or communicating that the owner is an admirer of abstract expressionism, but that does not make the painting "utilitarian." Just the opposite is true. Those kinds of functions of a work are paradigmatic non-utilitarian functions, even though it is possible to characterize those functions of the work as "useful."

Contemporaneous definitions of "utilitarian" confirm that Congress was not referring to a work's aesthetic, decorative, or cultural purposes. Webster's Third New International Dictionary 2525 (1966) (defining "utilitarian" as "characterized by or aiming at utility as distinguished from beauty or ornament;" defining "utility" as "the quality or state of being useful" or "something useful or designed primarily for use"); 11 Oxford English Dictionary 484 (1933) (defining "utilitarian" as "[o]f or pertaining to utility; relating to mere material interests," "[i]n quasi-depreciative use: Having regard to mere utility rather than beauty, amenity, etc.," and "preferring mere utility to beauty or amenity;" and defining "utility" as "[t]he fact, character, or quality of being useful or serviceable").

Along these same lines, clothing's usefulness in decorating or flattering a person's appearance does not make that aspect of the clothing utilitarian or useful in the practical, mechanical sense that the Copyright Act is concerned with. The useful aspect of clothing in practical terms is its physical utility in providing covering for the body or keeping the body warm or cool. Similarly, the utilitarian function of a chair is holding up a sitting person's body. That the chair accentuates its surroundings may make the chair aesthetically useful for someone who takes pride in the beauty of his home. But that does not make the chair's aesthetic appearance a utilitarian function of the chair.

Indeed, treating a work's decorative function as "utilitarian" would make almost every pictorial, graphic, or sculptural work utilitarian, because almost every such work has that kind of decorative function. An impressionist painting of a garden would be utilitarian and unprotectable because it conveys to

others the owner's love of gardens and flowers, or of the impressionist style. A chair with a nineteenth century English carving on its back would be utilitarian and unprotectable because it enhances the appearance of a Victorian-era house. *Cf.* House Report, at 55 (offering as an example of a protectable design "a carving on the back of a chair").

That cannot be right, as it would contradict the text and structure of section 101. In section 101, Congress clearly intended the word "utilitarian" as a *limitation on*, not a *broadening of*, the works and aspects of works that are not copyrightable. First, section 101 specifies that "[p]ictorial, graphic, and sculptural works" include "works of artistic craftsmanship" that have "*mechanical or utilitarian aspects*" as distinguished from their "*form*" or other artistic features. 17 U.S.C. § 101 (emphasis added). Petitioner's definition of "utilitarian" eliminates that distinction. Second, section 101 draws a distinction between "pictorial, graphic, or sculptural work[s]" that are "useful articles" from those that are not. *Id.* "[P]ictorial, graphic, or sculptural works" that are "useful articles . . . hav[e] an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." *Id.* Petitioner's definition of "utilitarian" would break down this distinction too and make virtually all pictorial, graphic, or sculptural works useful articles.[5]

---

[5] The absurd consequences from such a broad definition of utilitarian are readily apparent in the case of *Gay Toys, Inc. v. Buddy L Corp.*, 522 F. Supp. 622 (E.D. Mich. 1981), *vacated*, 703 F.2d 970 (6th Cir. 1983). There, the district court held a toy airplane was a non-copyrightable useful article because it "possesses utilitarian and functional characteristics in that it permits a child to dream and to let his or her imagination soar."

Third, with respect to "useful articles," the statute's separability test is premised on the notion that at least in some cases, "pictorial, graphic, or sculptural features" are separate and distinct from "utilitarian aspects." 17 U.S.C. § 101. Again, Petitioner's definition of utilitarian would eliminate this distinction, rendering superfluous the statutory command that courts must assess the non-utilitarian aspects of useful articles to determine if they are separable from the utilitarian aspects. *See Corley v. United States*, 556 U.S. 303, 314 (2009) ("A statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant.") (quoting *Hibbs v. Winn*, 542 U.S. 88, 101 (2004)).

It would make a hash of the statute to define utilitarian so broadly that it swallows every feature of a work. Yet that is how Petitioner and Petitioner's *amici* contend that "utilitarian" should be understood: that it knows no bounds. *See* Pet. Br. at 32 (defining utilitarian with respect to a prom dress to include "caus[ing] an observer to perceive that the wearer is attending the prom, draw attention to certain parts of the wearer's body and not others, and generally create a slimming effect"); Profs. Buccafusco & Fromer

---

522 F. Supp. at 625. The Sixth Circuit reversed, explaining that "a toy airplane is to be played with and enjoyed, but a painting of an airplane, which is copyrightable, is to be looked at and enjoyed. Other than the portrayal of a real airplane, a toy airplane, like a painting, has no intrinsic utilitarian function." *Gay Toys, Inc. v. Buddy L Corp.*, 703 F.2d 970, 973 (6th Cir. 1983). *See also* 2 Patry § 3:149, pp. 3-477 3-478 ("Toys and other playthings are not useful articles despite the purpose of stimulating children's (or adults') imaginations, since such intent is not an intrinsic utilitarian purpose within the meaning of the statute." (footnotes omitted)).

Amicus Br. at 4 (defining "the full scope of what is utilitarian" to include "expressive features of clothing designs" that "affect[] how the wearer is perceived"), at 8 (stating that garment design has utility "beyond standard mechanical or technological utility," in that it "is intended *to make the wearer look attractive*" (emphasis in original)), at 11 (defining any types of "designs or aspects of designs . whose value is *dependent on their effect on other objects*," as utilitarian; based on this broad understanding of utilitarian, defining the utility of clothing to include not only "the mechanical utility related to use, warmth, and modesty," but also "design features that influence the wearer's appearance" (emphasis in original)). That cannot be what Congress intended, as it would conflict with section 101's statutory structure and text as described above.

This Court's decisions in *Baker v. Selden* and *Mazer v. Stein*, which are codified in section 101, leave no doubt on this point. In *Baker v. Selden*, the Court explained that the division between utilitarian and expressive functions is an articulation of the border between copyright and patent. *See Baker*, 101 U.S. at 102. The bookkeeping system was not copyrightable because it fell into the category of "the rules and methods of useful art [that] have their final end in application and use." *Id.* at 104. In other words, the bookkeeping system was a practical activity; its value was in the tangible benefits it could bring about, not in the "pleasure in [its] contemplation." *Id.* By contrast, the text of the book was protectable because the unique arrangement of words and pictures describing the bookkeeping system was expressive—as the Court put it, it was the kind of object whose "essence consists

only in [its] statement." *Id.* Thus, the book was expressive, artistic, and copyrightable, notwithstanding its "practical" subject matter, or the fact that it was "useful" insofar as it served the useful function of teaching readers how to perform bookkeeping.

In *Mazer*, there was no question that the lamp base statuette at issue had practical, utilitarian elements that were not copyrightable: it supported a light bulb, its attendant wiring, and a lampshade. *See Mazer*, 347 U.S. at 202. But if "utilitarian" were given the broad meaning that Petitioner and Petitioner's *amici* advance, the statuette's creative and expressive elements could also be construed as utilitarian. For example, because the statuette was of a Balinese dancing figure, the lamp could be portrayed as "useful" for conveying to others the owner's appreciation for Balinese culture or for improving the appearance of the room. In holding that the statuette was copyrightable, the Court rejected any such sweeping meaning of "utilitarian."

Rugs and wallpaper are examples of two-dimensional useful articles that have uncontroversially copyrightable elements. A rug has the intrinsic utilitarian function of covering a floor and providing something soft for people to walk on. Wallpaper has the intrinsic utilitarian function of covering up walls. Nevertheless, rug and wallpaper designs are copyrightable in that they are decorative, and their pictorial and graphic features are understood to be separable from their utilitarian aspects. *See Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 137 (2d Cir. 2003); *Peel & Co., Inc. v. The Rug Market*, 238 F.3d 391, 399 (5th Cir. 2001); House Report, at 55 ("A two-dimensional painting,

drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like."). Conversely, what is *not* protectable is the utilitarian function of covering a floor or a wall. If a rug had a heating function or were soft or absorbent, or a wallpaper had a sound-absorbing function or were crayon-proof, those utilitarian functions would not be copyrightable, but they would not exclude from protectability the picture or graphic design embossed on that rug or wallpaper.

Rugs and wallpaper are examples of two-dimensional works, but the analysis is no different for three-dimensional works. The fact that a work is three-dimensional does not put the work in some different exceptional category from copyrightable works or from two-dimensional useful articles, and require a different kind of analysis. The same basic question that applies to two-dimensional useful articles like rugs and wallpaper applies as well to three-dimensional useful articles like clothing, cars, and furniture. That basic question, mandated by the statute, is the extent to which the useful article's pictorial, graphic, or sculptural features are separable from its utilitarian aspects.

A piece of clothing, a three-dimensional useful article, has the utilitarian function of physically covering the body, keeping someone warm or cool, enhancing physical comfort, or moving with the body during physical activity. Those aspects of a piece of clothing "have their final end in application and use." *Baker*, 101 U.S. at 104. A piece of clothing also has aesthetic, decorative, or cultural functions, such as making the wearer look attractive, flattering the body,

or signaling that one is stylish, wealthy, or fits in. These are not utilitarian functions of clothing, and neither is clothing's ability to convey one's identity as a trend-setter, a fashionista, or a cheerleader. Just as one may buy and display a particular painting to convey one's identity as a minimalist, one may buy a particular dress to convey that same identity. That the painting and the dress serve that cultural function does not make that function—or the painting or dress—utilitarian.

III. Expressive Features Are Conceptually Separable Where They Are Not Dictated By Utilitarian Function.

The dispositive question in this case is whether—just as with the design of a rug or wallpaper—the pictorial, graphic, or sculptural features of a particular piece of clothing are separable from its utilitarian aspects. For the vast majority of clothing, such features are not separable because, in general, most clothing designs are dictated by utilitarian considerations. However, to the extent that the design may have pictorial, graphic, or sculptural features that *are* separable from utilitarian aspects, then those features are protectable, as long as they satisfy copyright's standard requirements, such as originality.

This Court in *Kirtsaeng v. John Wiley & Sons, Inc.*, 133 S. Ct. 1351 (2013) took as a given the existence of design copyright in apparel. In the course of explaining the consequences of denying first sale status to copies made abroad and imported into the United States, the Court enumerated three examples of imported goods protected by copyright: "a video game made in Japan, a film made in Germany, or a dress (with a design

copyright) made in China." 133 S. Ct. at 1360. The only possible way of reading this sentence is as recognition that some dresses, which clearly are useful articles, have copyrightable designs or design features. That conclusion, moreover, is fully consistent with the Copyright Act's specification of the extent to which designs of useful articles are protectable: when their pictorial, graphic, or sculptural features—in other words, the decorative or artistic aspects of their designs—are separable from their utilitarian aspects.

Section 101's legislative history confirms that "separable" means *physically or conceptually separable*. House Report, at 55 ("Unless the shape of an automobile, airplane, ladies' dress, food processor, television set, or any other industrial product contains some element that, *physically or conceptually, can be identified as separable from the utilitarian aspects of that article*, the design would not be copyrighted under the bill.") (emphasis added). Numerous courts of appeals, including the Sixth Circuit in the case at bar, have confirmed that both physical and conceptual separability can be relevant considerations when determining whether a design's "pictorial, graphic, or sculptural features . can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101; *e.g.*, *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 483 (6th Cir. 2015); *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 917 (7th Cir. 2004); *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 433-34 (4th Cir. 2010) (per curiam); *Baby Buddies, Inc. v. Toys "R" Us, Inc.*, 611 F.3d 1308, 1315-16 (11th Cir. 2010); *Chosun Int'l, Inc. v.*

Chrisha Creations, Ltd., 413 F.3d 324, 328 (2d Cir. 2005).

Physical separability means, for example, that an appliqué sewn onto a sweater can be removed from (*e.g.*, snipped off of) the sweater and hence is protectable. *See Pivot Point*, 372 F.3d at 917. By contrast, conceptual separability means, for example, that the decorative features of a costume may be protectable if they are conceptually distinct from the costume's function as clothing even though they cannot be removed from the clothing. *See Chosun Int'l*, 413 F.3d at 329.

The instant *amici* propose the following test for separability: The design of a useful article is protectable if it is not dictated by, or necessary to, utilitarian or functional considerations. However, a design may be protectable even if it is *influenced* by functional considerations. *See* 2 Patry § 3:146, p. 3-475 ("If the pictorial, graphic, or sculptural features [of a useful article] are *not* dictated by the form or function of the utilitarian aspects of the useful article, they can be said to be capable of existing independently of those aspects and hence are protectable.") (emphasis in original).

The Second Circuit employed this analytical approach in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980) and *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985). In *Kieselstein-Cord*, the court considered the protectability of a series of decorative, ornamental belt buckles. 632 F.2d at 990-91. The court concluded that the belt buckles contained "conceptually separable sculptural elements," and thus were protectable,

because the buckles' ornamented surfaces were distinct from the buckles' utilitarian function of supporting pants. *Id.* at 993. Put differently, "the ornamented surfaces of the buckles" were protectable because they "were not in any respect *required by* their utilitarian functions." *Carol Barnhart*, 773 F.2d at 419 (emphasis added). Even if the belt buckles in *Kieselstein-Cord* did not have decorative elements on their surface, they still would have served their utilitarian function. *Id.* In *Carol Barnhart*, the court applied this same test and reached the opposite conclusion in a case involving mannequin-like forms designed to display clothing. *Id.* at 412-13. The forms at issue in *Carol Barnhart*, according to the Second Circuit, were unprotectable because their aesthetic components (life-like depictions of the human body) were necessary to the performance of the forms' utilitarian function—the display of clothing on a human torso. *Id.* at 419.

The test that *amici* advocate and that the Second Circuit has applied is the only test consistent with copyright law's longstanding principle that functional influences do not disqualify a work from copyright protection. *See* Part I *supra*. That articles containing utilitarian influences can be copyrighted was the very point of *Mazer v. Stein* and *Baker v. Selden*. Indeed, as noted above, *Mazer v. Stein* "reaffirm[ed] the gist of the holding in *Baker* and . . . the idea—first articulated in *Baker*—that useful works do not *ipso facto* become ineligible for copyright protection." 1 Nimmer § 2A.05[B][1], p. 2A-26; *see also* 2 Patry § 3:146, p. 3-475 (noting that the same type of test that *amici* propose is based on "a plain reading of the statute and one that takes full account of the statutory language. It is also

quite easy to apply, a distinct virtue.").[6] Moreover, the test keeps courts out of the business of making judgments about aesthetic value, a role for which courts are ill-suited. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (urging courts to avoid the "dangerous undertaking" of making judgments about aesthetic worth, "outside of the narrowest and most obvious limits.").

Importantly, the test *amici* advocate is consistent with the well-established rule that the designs of two-dimensional useful articles, such as rugs, wallpaper, and fabric, are copyrightable even though they are influenced by functional considerations. *See Tufenkian*, 338 F.3d at 137; *Peel & Co.*, 238 F.3d at 399; *Tilley v. TJX Cos.*, 345 F.3d 34, 36 (1st Cir. 2003). That is because a rug's design is not dictated by utilitarian considerations, such as the need for it to lay flat on the floor and feel soft to one's feet. The same well-established rule applies to three-dimensional useful articles such as apparel, and *amici*'s test applies to three-dimensional useful articles just as it does to two-dimensional ones. The pictorial, graphic, and sculptural design features of three-dimensional useful articles are protectable to the extent that they are not dictated by or necessary to the article's utilitarian function. In the

---

[6] By contrast, the test that Petitioner's *amici* intellectual property professors suggest would deny protection whenever the claimed set of features is itself a useful article. Brief *Amicus Curiae* on Behalf of Intellectual Property Professors in Support of Petitioner (hereinafter "Intellectual Prop. Profs. *Amicus* Br."), at 8-10. Among other problems, their test would deny protection even to the belt buckle designs in *Kieselstein-Cord*, *id.* at 23-24 (asserting that *Kieselstein-Cord* was wrongly decided), despite their being merely ornamental and unnecessary to the function of the buckles.

case of clothing, this means that the pictorial, graphic, and sculptural design features of a dress are protectable as long as they are not dictated by the utilitarian functions of physically covering the body, keeping the body warm or cool, enhancing physical comfort, or moving with the body during physical activity.

In stark contrast to this straightforward analytical approach, Petitioner's test for separability is unworkable and would create a host of problems. Petitioner proposes first that a court assessing protectability must "identify *all* of [an] article's inherent, essential, or natural functions." Pet. Br. at 38 (emphasis in original). "[I]f an article has a useful function that is inherent, essential, or natural to what the article is, then it is a useful article." *Id.* at 29-30; *see also id.* at 38. This approach makes the scope of "useful articles" under section 101 incredibly broad, and would sweep in many objects that plainly are not "useful articles" within the plain meaning of the statute, such as paintings that stimulate deep emotions in the viewer or that create a certain ambiance or mood in the room where they are displayed.

If an object is a useful article under Petitioner's test—as most objects would be—that is essentially outcome determinative as to whether the object or any of its features is copyrightable. It would be virtually impossible for the features of any useful article to pass Petitioner's test for copyright protection, first because Petitioner applies a "presumption" against copyright protection to all useful articles—a presumption

Petitioner creates from whole cloth[7]—and second because Petitioner applies a highly regimented separability analysis that is skewed in every respect against copyright protection. Pet. Br. at 27-36, 38-39. For example, Petitioner requires the feature at issue to be "purely artistic" without any "utilitarian aspects." *Id.* at 38. "If the feature is *even slightly utilitarian*, it cannot be copyrighted." *Id.* at 39 (emphasis added).

Petitioner's *amici*'s approach to separability is also unworkable. As discussed in Part II *supra*, their definition of "utilitarian" is incredibly broad, such that any feature of a useful article would count as utilitarian, no matter how artistic or decorative. Under this approach, virtually all design features that are expressive are simultaneously utilitarian, and are therefore unprotectable: "Where, however, the components of a design that are claimed as the expressive pictorial, graphic, or sculptural features also, simultaneously, function as utilitarian aspects of the article they could never maintain separable identification and existence." Profs. Buccafusco & Fromer *Amicus* Br. at 30.

The approach proposed by Petitioner and Petitioner's *amici* is not what Congress could have intended in requiring courts to inquire into the separability of a work's pictorial, graphic, or sculptural features from its utilitarian aspects. Under Petitioner's

---

[7] Congress's intent in setting forth the separability test in section 101 was to codify this Court's holding in *Mazer*, which made no reference to any presumption against copyright protection for useful articles. *See* Part I *supra*; *Mazer*, 347 U.S. at 210-17.

and Petitioner's *amici*'s approach, the decorative character of a useful article would be considered a useful function, which would render the two-dimensional designs of rugs, wallpaper, and fabric no longer protectable. Once decoration is defined as utilitarian, the rug's decorative features cannot be separated from its utilitarian aspects. Given that this result contradicts longstanding precedent and the legislative history cited above, Petitioner's and Petitioner's *amici*'s approach cannot be correct.

Fundamentally, nothing in the statute's text suggests that separability should apply to the designs of three-dimensional useful articles differently than it applies to the designs of two-dimensional articles. Indeed, the statute specifically suggests the opposite: that three-dimensional and two-dimensional useful articles are protectable under the same conditions. *See* 17 U.S.C. § 101. Thus, the pictorial, graphic, or sculptural features of clothing design are to be treated just like the pictorial, graphic, or sculptural features of fabric design: if they are dictated by utilitarian function, they are not copyrightable, but if they are not dictated by utilitarian function, then they are copyrightable.

Applying this test to the cheerleading uniforms at issue here, the question is whether the particular selection and arrangement of chevrons and stripes on the uniforms is dictated by or necessary to the utilitarian function of a cheerleading uniform.[8] The

---

[8] Petitioner errs in suggesting that the issue before the Court is whether a stripe or a chevron printed onto clothing is copyrightable. *See* Pet. Br. at 44-45. To the contrary, the issue before the Court is whether the particular arrangement of

utilitarian function is to clothe the wearer, move with the body for purposes of athletic activity, keep the body comfortable and cool, wick away moisture, and the like. Insofar as the uniform serves to identify the wearer as a cheerleader, or serves to make the wearer look attractive, that is not a utilitarian function; it is an aesthetic or cultural function. *See* Part II *supra*. The design of chevrons and stripes on the uniform is not dictated by or necessary to the uniform's utilitarian function. For example, if the chevrons or stripes were absent, were arranged differently, or were replaced by a polka dot design, the uniform would still serve its utilitarian function.[9]

Although Petitioner suggests that Respondents' designs are not very creative, Pet. Br. at 48-49, that criticism is not relevant to whether the designs have pictorial, graphic, or sculptural elements that are separable from their utilitarian aspects. On remand,

---

chevrons and stripes that appear on the cheerleading uniforms is copyrightable. Brief for the Respondents in Opposition to Certiorari at 1-3. Respondents have not argued that the general concept of a chevron or a stripe is copyrightable.

[9] Notably, Petitioner's *amici* intellectual property professors advocate a separability test that favors Respondents when applied to the cheerleading uniforms at issue in this case. Petitioner's *amici* claim that under their test, the "aesthetic elements" of a cheerleading uniform are unprotectable because they "exist only as part of a cheerleader uniform. There is nothing to extract; the claimant claims the design of a useful article." Intellectual Prop. Profs. *Amicus* Br. at 17. That, however, is plainly wrong. If designs on the surface of wallpaper can be "extracted" under Petitioner's *amici*'s separability test—as Petitioner's *amici* claim, *id.* at 8, 17—then so can designs on the surface of clothing, including cheerleading uniforms.

the court can decide whether Respondents' designs are not sufficiently original and not copyrightable for that reason. *See* 17 U.S.C. § 102(a); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 449 U.S. 340, 345 (1991).

Petitioners are also incorrect in their assessment of the policy implications of their preferred rule. Pet. Br. at 57. Far from suppressing innovation, copyright protection for separable expressive features encourages innovation. As the instant *amici* have explained in their academic work:

> Mass copyists undermine the market for the copied good. Copies reduce the profitability of originals, thus reducing the prospective incentive to develop new designs in the first place. The predicted result, a reduced amount of innovation, is familiar from copying in other creative industries, such as file sharing of copyrighted music and films.

C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147, 1174 (2009). In this respect too, useful articles' separable expressive features are like other creative works. Denying protection here can be expected to reduce innovation by making Respondents' creative contributions easy prey for pirates.

IV. The Copyrightability Of Overall Design Of Clothing Is Not At Issue In This Case.

The instant case does not turn on whether the overall design of a piece of clothing—the combined selection and arrangement of shape, cut, fit, color, drape, neckline, hemline, sleeve width and length, cuff, etc.—is copyrightable. This case presents only the

question of the copyrightability of a design that appears on Respondents' cheerleading uniforms, rather than the copyrightability of the uniforms' overall design. Seventy-five years ago, this Court treated overall dress designs as unprotectable by copyright. *Fashion Originators' Guild of Am., Inc. v. FTC*, 312 U.S. 457 (1941); *see* C. Scott Hemphill & Jeannie Suk, *The Fashion Originators' Guild of America: Self-Help at the Edge of IP and Antitrust*, in *Intellectual Property at the Edge: The Contested Contours of IP* 159, 176 (Rochelle C. Dreyfus & Jane C. Ginsburg eds., 2013).

This case does not require the Court to revisit the question of whether the overall design of an item of apparel is copyrightable. Respondents have not asserted a copyright in overall design. If the Court were to address this question, there are two possible approaches. On the one hand, consistent with this Court's mention in *Kirtsaeng* of "a dress (with a design copyright)," 133 S. Ct. at 1360, the Copyright Act's text and its separability requirement for useful articles does not foreclose protection for overall dress design.

On the other hand, the Copyright Office has taken a different view, interpreting the statute not to provide protection for overall design. This is because the Copyright Office perceives an extra requirement beyond an examination of the claimed expressive features, namely whether the useful article would survive a hypothetical removal of the expressive features. Compendium of U.S. Copyright Office Practices § 924.2(B), at 900:40 (3d ed. 2014). The Copyright Office's premise is that the protectable elements must be "capable of being visualized . as a work of authorship that is independent from the overall

shape of the useful article." *Id.* If what would remain after hypothetical removal of the work's expressive features is not itself a "fully realized, separate work[]," *id.*, the Copyright Office would deny protection. Under this test, copyright protection for any "integral part of the overall shape"—such as a dress's unique aesthetic design—is impossible, "because removing it would destroy the basic shape of the useful article." *Id.* at 900:41.

The instant *amici*'s proposed test for separability harmonizes with either understanding: the one that focuses on the text of the Copyright Act, which is consistent with protection of overall design, or the one that follows the Copyright Office. But the Court need not decide between them here, because the instant case does not turn on whether overall design of items of apparel would be protectable.

CONCLUSION

Whether the design features of a three-dimensional useful article, such as a dress, are copyrightable, is simply a manifestation of a question that runs throughout copyright law: How does copyright protect an object's artistic aspects while denying protection to its utilitarian functions? In *Baker v. Selden* and *Mazer v. Stein*, this Court made clear that an object's utilitarian aspects do not foreclose copyright protection for its artistic aspects. The question under the Copyright Act for three-dimensional and two-dimensional useful articles is whether an article's artistic features can be separated from the article's utilitarian ones. *Amici* submit that the proper test for separability—the only test that is consistent with the statute and basic principles of copyright law—is clear

and straightforward: the graphic, pictorial, or sculptural aspects of a useful article are copyrightable if they are not dictated by the article's utilitarian function, with the term "utilitarian" properly understood in its practical, mechanical sense.

Respectfully submitted,

JEANNIE SUK GERSEN
HARVARD LAW SCHOOL
1563 Massachusetts Ave.
Cambridge, MA 02138

C. SCOTT HEMPHILL
NEW YORK UNIVERSITY
SCHOOL OF LAW
40 Washington Sq. South
New York, NY 10012

SCOTT B. WILKENS
Counsel of Record
MATTHEW S. HELLMAN
SAMUEL C. BIRNBAUM*
JENNER & BLOCK LLP
1099 New York Ave. NW
Suite 900
Washington, DC 20001
(202) 639-6000
swilkens@jenner.com

**Admitted only in New York. Practicing under the supervision of the partnership of Jenner & Block LLP*

Counsel for Amici Curiae

September 21, 2016